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In re Application of
OTT, Josef : DECISION ON
Application No.: 10/580,344 :
PCT No.: PCT/CH04/00700 : PETITION
Int. Filing Date: 19 November 2004 :
Priority Date: 26 November 2003 : UNDER 37 CFR 1.47(b)
Attorney's Docket No.: Q95051 :
For: Seal For Affecting A Sealing Between Parts Having
Limited Mobility :

This is a decision on applicant's "Petition Under 37 C.F.R. 1.47(b)," filed in the United States Patent and Trademark Office on 01 August 2007 on behalf of the assignee and the non-signing inventor Josef Ott.

BACKGROUND

On 19 November 2004, applicant filed international application PCT/CH04/00700, claiming a priority date of 26 November 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 26 May 2006.

On 25 May 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied, *inter alia*, by the requisite basic national fee and a Memorandum of Law ("Memorandum") explaining the Swiss Code of Obligations (CO) that determines ownership of inventions as between an employer and an employee under Swiss law.

On 12 April 2007, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 01 August 2007, applicant submitted, *inter alia*, the declaration, the surcharge for late filing of the declaration, a two-month extension fee, a declaration of relevant facts by Mr. Stefan Day, a declaration by Mr. Stefan Harke and, the present petition filed under 37 CFR 1.47(b) requesting acceptance of the application without the signature of the applicant.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

As to item (1), applicants have submitted an incorrect fee of \$130.00. The correct fee for a petition filed under 37 CFR 1.47(b) is \$200.00 under 37 CFR 1.17(g). Based on applicant's authorization filed with the instant petition on 01 August 2007, an additional amount of \$70.00 will be charged to Deposit Account No. 19-4880.

With regard to item (2), the declaration of Mr. Stefan Day ("Declaration"), a person having first-hand knowledge of the facts recited, indicates that assignment papers and a declaration were sent to Mr. Josef Ott on two occasions; 16 August 2005 and 20 September 2005 (see Exhibits 3, 4 and 8). Further, the Declaration indicates that on 12 October 2005, Mr. Stefan Day had a telephonic conversation with Mr. Josef Ott, in which Mr. Josef Ott expressly stated that he does not intend to execute the declaration. Although the Declaration indicates an express oral refusal, the Declaration does not provide any evidence that non-signing inventor Josef Ott was presented with a copy of the application papers (specification, claims, drawings and oath or declaration). Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, claims, drawings, and oath or declaration) to the non-signing inventor for signature such that the inventor understands what exactly he is being asked to sign. Copies of documentary evidence such as a certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that a complete copy of the application papers had been sent to the applicant should be made a part of the declaration or affidavit. Therefore, item (2) has not been satisfied.

With regard to item (3), the last known address of non-signing inventor Josef Ott is indicated as: Sonnenrainstrasse 10, 8735 St. Gallenkappel, Switzerland. Hence, item (3) has been satisfied.

With regard to item (4), the declaration executed by the 37 CFR 1.47(b) applicant does not comply with 37 C.F.R. 1.497(a)-(b) because the declaration has not been properly executed in accordance with 37 CFR §§1.497(b)(1) and 1.47(b). MPEP §409.03(b)(A) states that:

... Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration.

A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation.

...Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

In this case, the name of the person signing the declaration is not clear. Furthermore, the title of the person signing the declaration has not been provided. Hence, item (4) has not been satisfied.

With regard to item (5), the Memorandum of Law, filed by Mr. Stefan Day on 25 May 2006, indicates that under Swiss law, "inventions made by the employee belong to the employer if made in the course of employee's employment activities and contractual duties" (see page 2 of the Memorandum). However, applicant has not provided evidence as to the "employment and contractual duties" of Mr. Josef Ott while employed by the 37 CFR 1.47(b) applicant. Although, the employment agreements signed by Mr. Josef Ott (see Exhibits 11 and 12) indicate that he agreed to certain employment rules and regulations, the evidence does not indicate whether the invention was made as part of his "employment and contractual duties." It is noted that the declaration of Mr. Stefan Harke, Manager Laboratory and Measurement Engineering, appears to indicate that such "employment and contractual duties" are shown in Exhibit 1. However, a translation into the English language of Exhibit 1 has not been provided. A full translation into the English language of all documents filed in a language different than the English language is required. Therefore, the evidence provided is not sufficient to show that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter of the instant application to justify the filing of the application. Hence, item (5) has not been satisfied.

With regard to item (6), petitioner has demonstrated that irreparable harm will result if the application is not permitted to proceed. Hence, item (6) has been satisfied.

Based on the totality of the evidence currently of record, it would not be appropriate to consider the requirements of 37 CFR 1.47(b) to have been satisfied.

CONCLUSION

Applicant's petition requesting acceptance of the application without the signature of the inventor is **DISMISSED**, without prejudice, for the reasons described *supra*.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



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